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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/718,931 | 11/21/2000 | Paul D. Arling | 81230.578001 | 7074 |
| 34018 | 7590 | 12/21/2005 | | |
| GREENBERG TRAURIG, LLP 77 WEST WACKER DRIVE SUITE 2500 CHICAGO, IL 60601-1732 | | | EXAMINER YENKE, BRIAN P | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2614 | |

DATE MAILED: 12/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/718,931

Applicant(s)

ARLING ET AL.

Examiner

BRIAN P. YENKE

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Response (09 Nov 05).
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-9, 11 and 15-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-9, 11 and 15-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to the claims have been considered but are not persuasive.

Applicant's Arguments

a) Applicant states Uehira does not disclose a device with either a timer or programming which performs all the steps of storing, starting the timer, and in response to expiration of the predetermined interval causing the media device to return to the primary channel.

Examiner's Response

a) Initially the examiner would like to point out, that although the applicant's invention pertains to channel surfing/commercial skipping and returning to a main channel/program at the expiry of a predetermined time, the claims do not currently limit themselves to such an environment thus necessitating the rejection via Uehira, given the broadest interpretation of the claimed invention.

Uehira does disclose a remote which includes a timer/clock and programming which performs the required steps as stated below. As stated in the rejection, the user can input which programs to record/watch by entering the appropriate commands/actions, where the remote monitors the present time of the timepiece provided in the VTR 1 responsive to CPU 16 of the input device, and when the recording start times stored is equal to the time counted by the timepiece the information in the RAM 17 is read out of the input device and applied to the control circuit of the VTR (col 7, line 33-42). Thus if the 1st program to record is primary

channel 5 (i.e. user records channel 5 for 30 minutes, then channel 6 for 30 minutes, and then back to channel 5 for 30 minutes) and the second program is channel 6 and the third program is channel 5, the remote will instruct the media device (VTR) to return to the primary channel (5 in this instance) based upon the viewers recording instructions and times of recording.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 6-9, 11 and 15-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Uehira, US 4,755,883.

In considering claims 6 and 15,

a) the claimed timer... is met by remote controller 6 which includes a period to record (i.e. 30 minutes as shown in Fig 5A). Thus when the period is finished the next reserved no (would be 6 in this case is then recorded—which may be the from the same or different channel. Uehira discloses that remote 6 may include a timepiece so that the present time counter by the timepiece is displayed on display 8 (col 5, line 6-12).

b) the claimed a wireless transmitter... is met where the remote includes a wireless transmitter (via light emitting diode 9, Fig 4c)

c) the claimed memory... is met by memory 12, 13 along with CPU 11 (Fig 3)

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d) the claimed programming steps... is met where the user is able to program/select includes the recording start time, recording period of time, channel number of the TV a time or program number and the like (col 6, line 46-49). Wherein upon expiration of the currently being recorded video the remote transmits to the VCR/TV or the like the information necessary for the next recording/selection which may be the primary channel (i.e. user records channel 5 for 30 minutes, then channel 6 for 30 minutes, and then back to channel 5 for 30 minutes).

In considering claims 7-11 and 16-19,

Is met by Uehira which discloses that the key inputs/selection for the device channel up/down and the various recording options (col 4, line 35-62).

Conclusion

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Yenke whose telephone number is (571)272-7359. The examiner work schedule is Monday-Thursday, 0730-1830 hrs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John W. Miller, can be reached at (571)272-7353.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(571)-273-8300

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703)305-HELP.

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An automated message system is available 7 days a week, 24 hours a day providing informational responses to frequently asked questions and the ability to order certain documents. Customer service representatives are available to answer questions, send materials or connect customers with other offices of the USPTO from 8:30 a.m. - 8:00p.m. EST/EDT, Monday-Friday excluding federal holidays.

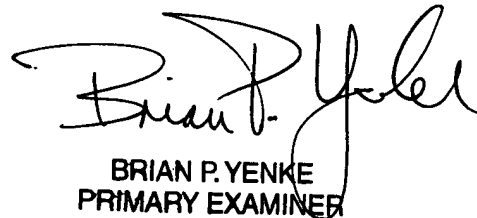
For other technical patent information needs, the Patent Assistance Center can be reached through customer service representatives at the above numbers, Monday through Friday (except federal holidays) from 8:30 a.m. to 5:00 p.m. EST/EDT.

The Patent Electronic Business Center (EBC) allows USPTO customers to retrieve data, check the status of pending actions, and submit information and applications. The tools currently available in the Patent EBC are Patent Application Information Retrieval (PAIR) and the Electronic Filing System (EFS).

PAIR (<http://pair.uspto.gov>) provides customers direct secure access to their own patent application status information, as well as to general patent information publicly available. EFS allows customers to electronically file patent application documents securely via the Internet. EFS is a system for submitting new utility patent applications and pre-grant publication submissions in electronic publication-ready form. EFS includes software to help customers prepare submissions in extensible Markup Language (XML) format and to assemble the various parts of the application as an electronic submission package. EFS also allows the submission of Computer Readable Format (CRF) sequence listings for pending biotechnology patent applications, which were filed in paper form.



B.P.Y.
16 December 2005



BRIAN P. YENKE
PRIMARY EXAMINER